

AMENDMENT AND RESPONSE UNDER 37 C.F.R. §1.116
Serial No. 10/655,331

REMARKS

Claims 17-24, 27-28 and 30-39 are pending in the present application. Applicants respectfully request reconsideration of the present claims in view of the following remarks.

I. Formal Matters:

Notice of Appeal

Applicants submit herewith a Notice of Appeal and the appropriate fee (\$500.00) for the Notice of Appeal.

Pre-Appeal Brief Request For Review

Applicants also submit herewith a Pre-Appeal Brief Request For Review. Applicants have requested a pre-appeal review for the reasons provided in the Pre-Appeal Brief Request, as well as the reasons provided below.

II. Prior Art Rejections:

Rejection of Previously Presented Claims 17-18, 21, 23-24, 35-37 and 39 Under 35 U.S.C. §102(b) In View Of PCT Publication No. WO91/10562 (Ochi)

Previously presented claims 17-18, 21, 23-24, 35-37 and 39 are rejected under 35 U.S.C. §102(b) as being anticipated by International Patent Publication No. WO91/10562 to Ochi et al. (hereinafter, "Ochi"). This rejection is respectfully traversed for at least the reasons provided in Applicants' April 24, 2006 Amendment and Response and in Applicants' October 11, 2005 Amendment and Response.

On page 3, lines 5-9 of the July 18, 2006 final Office Action, Examiner Tran states:

Regarding the limitations to the substrate derived from an aqueous dispersion and polyurethane clear coat layer, if any, derived from a solvent-based layer, it is noted that these limitations follow product-by-process format. Since the solvent or aqueous medium would not be present in the final article, which is claimed, it is the examiner's position that polyurethane layers formed by aqueous dispersions would be indistinguishable from those formed from solution.

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Applicants disagree.

As discussed in Applicants' October 11, 2005 Amendment and Response, Applicants' April 24, 2006 Amendment and Response and in the previously submitted December 21, 2001 Declaration of Dr. Falaas, polyurethane layers formed by aqueous dispersions are distinguishable from polyurethane layers formed from solution. The previously submitted Declaration of Dr. Falaas clearly states that polyurethane substrates derived from an aqueous urethane dispersion have a much higher elongation and tear strength properties when compared to polyurethane substrates derived from a solvent-based solution. See paragraphs (7), (8) and (10) of the Declaration.

The Declaration of Dr. Falaas clearly describes the distinctive structural characteristics of polyurethane substrates derived from an aqueous urethane dispersion and the differences in physical properties of (1) polyurethane substrates derived from an aqueous urethane dispersion as recited in independent claims 17 and 35 and (2) polyurethane substrates derived from a solvent-based solution. It is unclear to Applicants why Examiner Tran appears to completely ignore the previously submitted December 21, 2001 Declaration of Dr. Falaas, and the clear distinctions between polyurethane layers formed from aqueous dispersions and polyurethane layers formed a solvent based system as discussed therein.

As discussed in Applicants' October 11, 2005 Amendment and Response and Applicants' April 24, 2006 Amendment and Response, the claim language used to describe the polyurethane substrate feature as recited in independent claims 17 and 35 (i.e., "the polyurethane substrate is derived from an aqueous urethane dispersion") should be given patentable weight, not ignored by Examiner Tran. It should be noted that the Board of Appeals clearly gave weight to similar claim features recited in the pending claims of the parent application (now allowed claims 1-11 of U.S. Patent No. 6,071,621) of the present application. See, Board Decision, Appeal No. 1996-2472, decided on January 10, 2000, and in particular, footnote 2 on page 3 of the Board Decision.

For at least the reasons given above and in Applicants' October 11, 2005 Amendment and Response and Applicants' April 24, 2006 Amendment and Response, the disclosure of Ochi fails to anticipate Applicants' claimed invention as recited in

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previously presented claims 17-18, 21, 23-24, 35-37 and 39. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection of Previously Presented Claims 19-20 and 22 Under 35 U.S.C. §103(a)
In View Of Ochi In Combination With Dunning

Previously presented claims 19-20 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over the teaching of Ochi in combination with U.S. Patent No. 4,101,698 issued to Dunning et al. (hereinafter, "Dunning"). This rejection is respectfully traversed for at least the reasons provided in Applicants' April 24, 2006 Amendment and Response and in Applicants' October 11, 2005 Amendment and Response. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection of Previously Presented Claims 27-28, 30-31 and 38 Under 35 U.S.C.
§103(a) In View Of Dunning In Combination With Kunevicius

Previously presented claims 27-28, 30-31 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over the teaching of Dunning in combination with U.S. Patent No. 3,439,950 issued to Kunevicius (hereinafter, "Kunevicius"). This rejection is respectfully traversed for at least the reasons provided in Applicants' April 24, 2006 Amendment and Response and in Applicants' October 11, 2005 Amendment and Response. Accordingly, Applicants respectfully request withdrawal of this rejection.

Rejection of Previously Presented Claims 27-28, 30-34 and 38 Under 35 U.S.C.
§103(a) In View Of Ochi In Combination With Kunevicius

Previously presented claims 27-28, 30-34 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over the teaching of Ochi in combination with Kunevicius. This rejection is respectfully traversed for at least the reasons provided in Applicants' April 24, 2006 Amendment and Response and in Applicants' October 11, 2005 Amendment and Response. Accordingly, Applicants respectfully request withdrawal of this rejection.

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III. Conclusion:

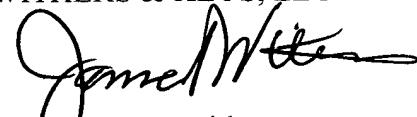
For at least the reasons given above, Applicants submit that claims 17-24, 27-28 and 30-39 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Should Examiner Tran believe that anything further is necessary to place the application in better condition for allowance, Examiner Tran is respectfully requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,

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